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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,142	01/26/2000	Jeffry Jovan Philyaw	PHLY-24,910	8141

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

21

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

1724

Office Action Summary	Application No.	Applicant(s)	
	09/491,142	PHILYAW ET AL.	
	Examiner	Art Unit	
	William C. Vaughn, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Wcn

DETAILED ACTION

1. This Action is in response to the latest papers received 22 September 2003 as well as the Amendment (see paper 17) received on 14 May 2003.

2. This Action is in response to the Reply and Amendment received 15 January 2002.

Priority

3. This application is a continuation of application 09/378,221, which is a continuation-in-part of application 09/151,530, now U.S. Patent No. Number 6,09,106, issued 01 August 2000, which is a continuation-in-part of application 09/151,471, now abandoned.

Specification

4. The disclosure is objected to because of the following informalities:

The specification references priority patent applications on Page 2 of the specification which have been finally disposed. The current state of these applications, reflecting the status of present pendency, (i.e., abandonment or patent maturity) including associated patent numbers, should be amended into the specification.

5. The application has been examined. **Original claims 22-34** are pending. The objections and rejections cited are as stated below:

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. **Claims 22-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. (Hudetz), U.S. Patent No. 5,978,773 in view of Wellner, U.S. Patent No. 5,640,193 and in further view of Lee et al. (Lee), U.S. Patent No. 6,263,383.

8. Regarding **claim 22**, Hudetz discloses the invention substantially as claimed. Hudetz discloses *a method for connecting a user computer at a first location on a network with a second location on the network through use of a coded symbol having contained therein encoded information associated with routing information on the network to the second location* [see Hudetz, Col. 3, lines 25-36] *thereover, comprising the steps of: extracting the encoded information from the coded symbol and decoding such extracted encoded information to provide decoded information* [see Hudetz, Col. 7, lines 2-9, Col. 11, lines 27-39]. However, Hudetz does not explicitly disclose inputting the decoded information to a defined port on the user computer which has an existing first functionality associated with the operation of the user computer which is not the same functionality as the step of inputting the decoded information, such that the step of inputting comprises a second functionality, with the port of the user computer operable to accommodate for both the first and second functionality during operation thereof; detecting operation under the second functionality when decoded information is input to the port; and in response to the step of detecting, connecting to the second location utilizing the decoded information as well as translating the second functionality to be compatible with the first functionality for input to the port.

9. In the same field of endeavor, Wellner discloses (e.g., multimedia service access by reading marks on an object). Wellner discloses *inputting the decoded information to a defined port on the user computer which has an existing first functionality associated with the operation*

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of the user computer which is not the same functionality as the step of inputting the decoded information, such that the step of inputting comprises a second functionality, with the port of the user computer operable to accommodate for both the first and second functionality during operation thereof; detecting operation under the second functionality when decoded information is input to the port; and in response to the step of detecting, connecting to the second location utilizing the decoded information (Wellner teaches having a memory to store a scanner pen identification (ID) code to, for example, distinguish signals from different scanner pens which communicate with interface (15). Scanner pen ID codes could be used to uniquely identify the user, if each user has his/her own scanner pen. In interface (15), the controller can then compare ID against a previously stored authorization table to determine if the user's request is authorized.), [see Wellner, Col. 2, lines 66-67 and Col. 3, lines 1-45];

10. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Wellner's teachings of multimedia service access by reading marks on an object with the teachings of Hudetz, for the purpose of utilizing the scanner id in order to facilitate connection and transmission of decoded information.

However, Hudetz-Wellner does not disclose translating the second functionality to be compatible with the first functionality for input to the port.

11. In the same field of endeavor, Lee discloses (e.g., keyboard wedge system and processing of data streams as well as a simplified configuration of barcode symbol scanning systems and processing of data streams). Lee discloses translating the second functionality to be compatible with the first functionality for input to the port (Lee teaches a hardware wedge interface whereas the keyboard (110) and the scanner (108) are plugged directly into the electronic gating circuitry

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of the keyboard wedge which is then plugged into the keyboard port of the computer.

Furthermore, the keyboard wedge passes typed keystrokes directly to the PC while scanned data from a scanner is first converted (translated) into keystrokes and then passed onto the keyboard line.), [see Lee, Col. 2, lines 22-67, Col. 3, lines 1-13, 59-67 and Col. 4, lines 1-15].

12. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Lee's teachings keyboard wedge system and processing of data streams as well as a simplified configuration of barcode symbol scanning systems and processing of data streams with the teachings of Hudetz-Wellner, for the purpose overcoming the need for time-consuming and complex manual scanner configuration [see Lee, Col. 3, lines 10-12]. By this rationale **claim 22** is rejected.

13. Regarding **claim 23**, Hudetz-Wellner and Lee further discloses *wherein the network comprises the Internet* [see Hudetz, Col. 9, lines 33-42]. By this rationale **claim 23** is rejected.

14. Regarding **claim 24**, Hudetz-Lee and Lee further discloses *wherein the coded symbol comprises a bar code* [see Hudetz, Col. 5, lines 22-29]. By this rationale **claim 24** is rejected.

15. Regarding **claim 25**, Hudetz-Wellner and Lee further discloses *wherein the bar code includes an UPC* [see Hudetz, Col. 6, lines 33-44]. By this rationale **claim 25** is rejected.

16. Regarding **claim 26**, Hudetz-Wellner and Lee further discloses *wherein the bar code includes coded therein an ISBN code* [see Hudetz, Col. 6, lines 33-44]. By this rationale **claim 26** is rejected.

17. Regarding **claim 27**, Hudetz-Wellner and Lee further discloses *wherein the bar code symbol contains therein an EAN code* [see Hudetz, Col. 6, lines 33-44]. By this rationale **claim 27** is rejected.

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18. Regarding **claim 28**, Hudetz-Wellner and Lee further discloses *wherein the coded symbol is disposed on a product* [see Hudetz, Col. 6, lines 20-25]. By this rationale **claim 28** is rejected.

19. Regarding **claim 29**, Hudetz-Wellner and Lee further discloses *wherein the encoded information comprises information related to the product and is unique thereto* [see Hudetz, Col. 6, lines 20-25]. By this rationale **claim 29** is rejected.

20. Regarding **claim 30**, Hudetz-Wellner and Lee further discloses *wherein the coded symbol comprises an optical symbol and the step of extracting comprises optically scanning the encoded information* [see Hudetz, Col. 6, lines 20-25]. By this rationale **claim 30** is rejected.

21. Regarding **claim 31**, Hudetz-Wellner and Lee further discloses *wherein the step of connecting comprises the steps of: interfacing the user computer through the network to an intermediate location on the network having a resource server and a resource database disposed* [see Hudetz, Col. 7, lines 2-42]; *transmitting the decoded information to the interface with intermediate locations* [see Hudetz, Col. 11, lines 27-40]; *the database having stored therein a table of routing information and a plurality of information for a plurality of second locations on the network* [see Hudetz, Col. 7, lines 57-67 and Col. 8, lines 1-10]; *and each of the routing information associated with one or more of different decoded information* [see Hudetz, Col. 8, lines 1-10]; *comparing the received decoded information with the stored decoded information* [see Hudetz, Col. 8, lines 1-46] *and, if there is a match, transmitting the associated routing information with the match decoding information back to the user computer* [see Hudetz, Col. 8, lines 21-53]; *and connecting the user computer with the second location in accordance with the routing information transferred from the intermediate location* [see Hudetz, Col. 11, lines 27-39]. By this rationale **claim 31** is rejected.

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22. Regarding **claims 32-34**, are substantially the same as claims 22 and 30 and are thus rejected for reasons similar to those in rejecting claims 22 and 30.

Claim Rejections - 35 USC § 103

23. **Claims 22-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (Lee), U.S. Patent No. 6,263,383 in view of Wang et al. (Wang), U.S. PG PUB US2002/0042736.

24. Regarding **claim 22**, Lee discloses the invention substantially as claimed. Lee discloses *a method for connecting a user computer at a first location on a network with a second location on the network through use of a coded symbol having contained therein encoded information associated with routing information on the network to the second location thereover, comprising the steps of: extracting the encoded information from the coded symbol and decoding such extracted encoded information to provide decoded information; inputting the decoded information to a defined port on the user computer which has an existing first functionality associated with the operation of the user computer which is not the same functionality as the step of inputting the decoded information, such that the step of inputting comprises a second functionality, with the port of the user computer operable to accommodate for both the first and second functionality during operation thereof; detecting operation under the second functionality when decoded information is input to the port; translating the second functionality to be compatible with the first functionality is input to the port* [see Lee, Col. 3, lines 59-67, Col. 4, lines 1-67]. However, Lee does not explicitly disclose in response to the step of detecting, connecting to the second location utilizing the decoded information.

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25. In the same field of endeavor, Wang discloses (e.g., universal product information lookup and display system). Wellner discloses *in response to the step of detecting, connecting to the second location utilizing the decoded information* [see Wang, Page 1, sections 0009-0013, page 2, sections 0026-0034].

26. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Wang's teachings of a universal product information lookup and display system with the teachings of Lee, for the purpose of overcoming time-consuming and complex manual scanner configuration.

27. Regarding dependent claims 23-34, the limitations of these claims are taught within the figures of Lee-Wang.

Double Patenting

28. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-34 are rejected under the judicially created doctrine of double patenting over claims 1- 9 of U. S. Patent No. 6,615,268 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the U.S. Patent No. 6,615,268.

Response to Arguments

29. Applicant's arguments include the failure of previously applied art to expressly disclose a device having first and second functionality as well as translating the second functionality to be compatible with the first functionality for input to the port (see Applicant Response, pages 6 and 7 of Paper# 17). It is evident from the detailed mappings found in the above rejection(s) Hudetz-Wellner and Lee in combination taught the disclosed functionality and that the provision for a database associating a unique audio designation and routing information over the global communication, was widely implemented in the networking art. Thus, Applicant's arguments

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drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive.

30. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique (see page 28, line 16 through page 34, line 8 of Applicant's specification). As it is extremely well known in the networking art as already shown by Hudetz-Wellner and Lee and other prior arts of records disclosed, for user's in a internet television programming environment to be reminder through the use of e-mail of specific televised programs through the internet as well as other claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

31. Applicant has had numerous opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

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32. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

33. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Citation of Pertinent Prior Art

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Wilz, St. et al. (Wilz), U.S. Patent No. 5,992,752 discloses translations and conversion of retrieved information elements to HTML encoded web page for display on a display screen [see Wilz, Col. 27, 47-62].
- b. Lieb et al. (Lieb), U.S. Patent No. 5,875,415 discloses a host interface device that translates data [see Lieb, abstract, item 30, Col. 3, lines 29-35].

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c. Wang et al. (Wang), U.S. PGPUB US2002/0042736 discloses a keyboard wedge interface (wedge interface), [see Wang, page 2, section 0026].

d. Shih, U.S. Patent No. 6,503,626 discloses an interface for translating of information between a keyboard and a scanner device [see Shih, Figure 4, item 44].

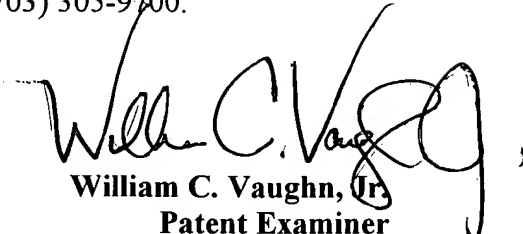
e. Nathan, U.S. Patent No. 5,848,292 discloses a wedge interface controller for translation of information between different devices included but not limited to keyboard and scanner [see Nathan, item 34, Col. 2, lines 39-67, Col. 3, lines 1-34, 59-67 and Col. 4, lines 1-65]

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.


William C. Vaughn, Jr.
Patent Examiner
Art Unit 2143
29 October 2003